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In re Application of:  
BOSKAMP, EDDY B.  
Serial No. 10/063,550  
Filed: May 2, 2002  
Docket: GEMS8081.091  
Title: WIRELESS RF MODULE FOR AN MR  
IMAGING SYSTEM

8/5/08

DECISION ON PETITION

This is a decision on the petition filed on January 17, 2008. Petitioner is requesting to withdraw the holding of abandonment and to withdraw the holding of a non-compliant appeal brief. This petition is being considered pursuant to 37 CFR 1.181. No fee is required under this section.

The petition is DISMISSED.

The relevant portion of the record shows that:

1. A Final Rejection was mailed on February 23, 2005.
2. An Amendment After Final Rejection under 37 CFR 1.116 was filed on August 17, 2005.
3. On August 23 2005, an Appeal Brief was filed.
3. A Notification of Non-Compliant Appeal Brief was mailed on November 2, 2005.
4. A Response to Notification of Non-Compliant Appeal Brief was filed on December 1, 2005. In this response, the applicant asserted that the examiner and the applicant had a telephone conversation and agreed that the August 17, 2005 Amendment After Final Rejection would be entered. However, the record does not show a record of the telephone conversation. No telephone summary form was completed by the examiner. The applicant submitted his record of the telephone conversation after Nov. 2, 2005.
5. The notice of abandonment was mailed on November 21, 2007 due to the applicant's failure to timely file a proper reply to the November 2, 2005 Notification of Non-Compliant Appeal Brief.
6. The present petition was filed on January 17, 2008. The petitioner requests withdrawal of the abandonment as well as withdrawal of the November 2, 2005 Notification of Non-Compliant Appeal Brief.

### Analysis and Discussion

The Notification of Non-Compliant Appeal Brief of November 2, 2005 indicated the August 17, 2005 amendment introduced the new element of "UHF carrier frequency signal" to claim 17. This element was not present in the claim prior to the Final Rejection. Thus, the amendment to claim 17 adding the UHF element was not enterable after the Final Rejection. The amendment of August 17, 2005 under 37 CFR 1.116 has changed the scope of the claims under appeal. Thus, the August 23, 2005 Appeal Brief was considered defective because the August 17, 2005 amendment introduced a new issue in an Amendment After Final Rejection. In addition, the amended claim was broadened with regard to omission of a limitation. Specifically, claim 17 was amended by the deletion of "batteryless means for powering the means for wirelessly transmitting". The amended claims were not enterable after the Final Rejection of February 23, 2005 under 37 CFR 1.116.

The petitioner asserts that the August 17, 2005 amendment was in response to the examiner's suggestions and thus in compliance with the rules regarding Amendments After Final Rejections. However, the alleged telephone conversation between the examiner and the applicant was not included in the official record until after issuance of the November 2, 2005 Notification of Non-Compliant Appeal Brief when the applicant submitted his response to the Notification of Non-Compliant Appeal Brief. Under 37 C.F.R. § 1.2, business must be transacted in writing.<sup>1</sup> There was no record of any suggestion made by the examiner in a telephone conversation on or about November 2, 2005 when the Notification of Non-Compliant Appeal Brief was mailed. Thus, the August 17, 2005 Amendment After Final Rejection can not be entered and the August 23, 2005 Appeal Brief was defective.

After receiving the November 2, 2005 Notification of Non-Compliant Appeal Brief, the applicant filed a response on December 1, 2005. In this response, the applicant asserted that the August 17, 2005 amendment was made in response to a suggestion by the examiner during a telephone conversation. As a proper response to a Notification of Non-Compliant Appeal Brief, an applicant may file an amended brief or file a petition under 37 CFR 1.181 or 41.3, pursuant to MPEP 1205.03.<sup>2</sup> Thus, the applicant's December 1, 2005 Response to Notification of Non-Compliant Appeal Brief was not a proper reply to the November 2, 2005 Notification of Non-Compliant Appeal Brief. Regrettably, the applicant's response to have the August 17, 2005 amendment entered was improper. Accordingly, the application was abandoned.

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<sup>1</sup> 37 C.F.R. 1.2 states:

All business with the Patent and Trademark Office Should be transacted in writing. The person attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

<sup>2</sup> MPEP 1205.03, second paragraph, states:

Under 37 CFR \*>41.37(d)<, the appellant may file an amended brief to correct \*>the< deficiencies in the original brief. Moreover, if appellant disagrees with the \* holding of noncompliance, a petition under 37 CFR 1.181 >or 41.3< may be filed. >Filing a petition will not toll the time period. Appellant must timely reply to the notice or the Office communication that requires an amended brief.

The present petition was filed on January 17, 2008 under 37 CFR 1.181 and states the petitioner's reasons for disagreeing with the November 2, 2005 Notification of Non-Compliant Appeal Brief. Unfortunately, the present petition is untimely, as the period to reply to the November 2, 2005 Notification of Non-Compliant Appeal Brief has expired. Thus, the present petition cannot be granted.

Conclusion

The record shows that a timely response to the November 2, 2005 Notification of Non-Compliant Appeal Brief was not filed. The present petition was filed on January 17, 2008, which is untimely pursuant to MPEP 1205.03 and 37 CFR 1.136. In view of the above, the requested relief cannot be granted under 37 CFR 1.181.

Any request for reconsideration should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" and must be submitted within TWO (2) MONTHS from the mail date of this decision. The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings (37 CFR 1.181(f)). No extension of time under 37 CFR 1.136(a) is permitted.

A petition to revive under 37 CFR § 1.137, including the required fee and a compliant brief, should be separately filed and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner at (571) 272-4856.

PETITION DISMISSED.

  
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Frederick R. Schmidt, Director  
Technology Center 3700